

REMARKS-General

1. The newly drafted independent claims 11 and 17 incorporate all structural limitations of the original claim 1 and include further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 11-22 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

2. With regard to the rejection of record based on prior art, Applicant will advance arguments to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the prior art of record. Reconsideration of the present application is requested.

Response to Objection to Drawings

3. The applicant respectfully submits that the originally filed claims 8-10 have been canceled and therefore the objection raised by the examiner should be withdrawn.

Response to Rejection of Claims 8-10 under 35USC112

4. The applicant submits that the newly drafted claims 11-22 particularly point out and distinctly claim the subject matter of the instant invention, as pursuant to 35USC112.

Regarding to the Rejection of Claims 1 and 6-7 under 35USC102

5. The examiner rejected claims 1 and 6-7 under 35USC102(b) as being anticipated by Hirayama (US 4,547,705). Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(b) the *invention* was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

6. In view of 35 U.S.C. 102(b), it is apparent that a person shall **not** be entitled to a patent when his or her **invention was patent** in this country more than one year prior to the date of the application for patent in the United States.

7. However, the Hirayama patent and the instant invention are **not the same invention** according to the fact that the disclosure of Hirayama patent does not read upon the instant invention and the independent claims 11 and 17 of the instant invention do not read upon Hirayama patent either.

8. The applicant respectfully identifies the differences between the instant invention and Hirayama for the purpose of overcoming the rejections under 35USC102(b) as follows.

9. Regarding the newly drafted independent claims 11 and 17, Hirayama fails to anticipate magnetic light and a magnetic energy generator, which comprises a pair of magnetic members each having a predetermined cross sectional shape to define a facing side and a opposite outer side, and at least a **first indented groove** indently formed at a predetermined position of the facing side of the magnetic member, wherein the magnetic members are arranged to be securely positioned such that the facing sides of the magnetic members are positioned in an edge-to-edge manner so as to allow the first indented groove of each of the magnetic members to substantially align and communicate with each other to form a first magnetic air gap within the first indented grooves of the magnetic members, **an insulated bakelite frame provided onto the magnetic members**, and an electromagnetic coil comprising at the one enameled magnet wire repeatedly wound on the insulated bakelite frames on the magnetic members so as to achieve a stable electromagnetic intensity of a completed magnetic circuit at the magnetic members.

10. Hirayama merely discloses two fluorescent lamps lightened by a single inverter circuit. More specifically, Hirayama merely discloses a **leakage transformer**, which comprises a magnetic core, a primary winding wound around the core and **coupled with the inverter circuit**, a pair of **secondary windings** each coupled directly with a related discharge lamp, **filament windings** coupled with filaments of related discharge lamps, wherein the magnetic core is a closed magnetic core with at least a pair of legs which bridge the closed magnetic core, each of the legs having a **non-**

magnetic gap between the end of the leg and the closed magnetic core, a first window defined between the pair of legs, second and a third windows defined by one of the legs and a part of the closed magnetic core, the primary winding being located in the first window and being coupled with an inverter circuit, the first secondary winding being located in the second window and being coupled with a first one of the discharge lamps, the second secondary winding being located in the third window and being coupled with a second one of the discharge lamps (Hirayama, Claim 1).

11. In the instant invention, as recited in claim 11 and 17, there is only one indentation groove formed on the respective magnetic body, and the indented groove is not designated for coupling with an inverter circuit and discharge lamps. Rather, the inverter circuit, which is an essential element for Hirayama's invention and is disclosed and claimed in Hirayama, is not present in the instant invention. The examiner refers to Fig. 6b as an anticipation of the instant invention. In response, the applicant respectfully submits that Fig. 6b of Hirayama merely discloses a magnetic core having a plurality of through compartments, whereas in the instant invention, at least one indented slot suffices. No leg is required to be formed in the instant invention. Moreover, the interaction between the various components of the instant invention as recited in claims 11 and 17 is not anticipated by Hirayama.

12. Specifically regarding to claim 17, Hirayama fails to anticipate a light body having an inner cavity, and comprising a fluorescent coated onto the inner cavity, a predetermined amount of inert gas and a predetermined amount of mercury received within the inner cavity, wherein the light body is arranged to securely mount in the first magnetic air gap so that when the magnetic energy generator is activated, a stable electromagnetic field is generated for illuminating the light body. Since there is no anticipation of the magnetic energy generator, Hirayama cannot anticipate that any light body is arranged to pass through the magnetic air gap formed in the magnetic energy generator. Moreover, nothing in Hirayama anticipate the light body in the first place.

Response to Rejection of Claims 2-5 and 8-10 under 35USC103

13. The Examiner rejected claims 2 and 4-5 under 35USC103(a) as being unpatentable over Hirayama in view of Thompson (US 5,395,218). Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

14. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

15. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Hirayama which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Thompson at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. The applicant respectfully submits that the differences between the instant invention and Hirayama are not obvious in view of Thompson under 35USC103(a), due to the reasons explained below.

16. Referring to the newly drafted independent claim 11 and 18, based on the originally filed set of claims, the examiner is of the view that Thompson teaches the electromagnetic coil and the insulated bakelite frame provided on the magnetic members, and therefore it would have been obvious for one having ordinary skill in the art to combine Hirayama with Thompson to produce the instant invention. In response, the applicant respectfully submits that Thompson merely discloses **a fluid pump**

apparatus including an elongated chamber within which a pair of pistons are movable. **An external magnetic drive system oscillates the pistons back and forth within the chamber, and includes two pairs of electrically conductive windings.** The windings are energized in such a way that they cause the pistons to oscillate in unison with one another (Thompson, Abstract). The examiner refers to Fig. 1, elements 62, 52 and 54 as an anticipation of the electromagnetic coil and the insulated bakelite. These are disclosed as conductive windings and side plates in general. And they are used to move the pistons of the fluid pump. The disclosure in Thompson has nothing to do with the magnetic light disclosed in the instant invention.

17. The examiner argues that Thompson teaches surrounding electrical windings with bakelite in order to electrically insulate the windings from adjacent windings. However, the applicant emphasizes that the invention must be considered as a whole. There is nothing in Thompson to suggest that any part of disclosed invention can be used in a manner recited in claims 11 and 17 of the instant invention. Any combination of them would have involved substantial inventive steps, which should pass the obviousness muster under 35USC103(a).

18. As mentioned earlier, the disclosure of Hirayama does not even anticipate the all of the features contained in the instant invention as recited in claims 11 and 18 apart from the insulated bakelite and the electromagnetic coil as suggested by the examiner. As a result, even combining Hirayama and Thompson would not provide the invention as claimed -- a clear indicia of nonobviousness. *Ex parte Schwartz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992), ("Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed."). That is, modifying Hirayama with the teaching disclosed in Thompson, as proposed by the examiner, would not provide the instant invention, at least because Hirayama does not disclose a magnetic light as recited in claim 18 of the instant invention.

19. In any event, Hirayama and Thompson fail to suggest, teach or motivate the magnetic energy generator as recited in claims 12-16 and 18-22. The examiner is of the view that engaging shoulder can be defined as surface. The applicant respectfully

submits that the function of the engaging shoulder is to keep the magnetic members in position with respect to each other without using additional devices or apparatus. As such, this function cannot be achieved by any surface. Rather, the engaging shoulder must be of at least an L-shaped cross section. These features are not taught by Hirayama and Thompson.

20. The applicant respectfully submits that the instant invention involves a magnetic energy generator for magnetic light. The cited references, especially Thompson, do not involve the same field of technology. As a result, the advantages of having the particular embodiment recited in claims 11 and 18 are not taught or even suggested in both Hirayama and Thompson. This renders the instant invention unobvious over prior arts.

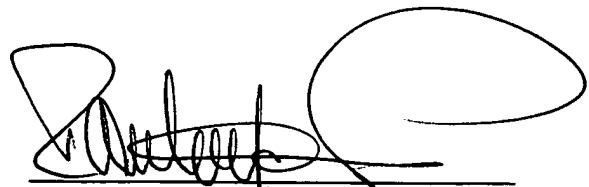
The Cited but Non-Applied References

21. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

22. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 11-22 at an early date is solicited.

23. Should the examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Raymond Y. Chan', is written over a horizontal line. The signature is stylized with loops and a large circular flourish on the right side.

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Date: _____

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